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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,389	03/29/2002	Tetsujiro Kondo	450108-03398	2393

20999 7590 03/13/2007
FROMMER LAWRENCE & HAUG
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EXAMINER	
FLANDERS, ANDREW C	
ART UNIT	PAPER NUMBER
2615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/089,389	KONDO ET AL.	
	Examiner	Art Unit	
	Andrew C. Flanders	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 20 December 2006 have been fully considered but they are not persuasive.

In section I Applicant states: "A Terminal Disclaimer has been filed to obviate the non-statutory Obviousness-type Double Patenting rejection." However, after a review of the file, the Examiner is unable to locate the Terminal Disclaimer. As a result, the Double Patenting rejections stand.

In section II, Applicant states: "Applicants submit that the recitation 'prediction calculation means for prediction-calculating the input digital signal by a prediction method corresponding to the class to generate a digital signal converted from the input digital signal'... refers to a useful process and result which meets the guidelines of statutory subject matter of a claimed invention under 35 U.S.C. 101 laws.'"

However, interim guidelines state that the result must not only be useful, but concrete and tangible as well. Examiner submits that 'generating a digital signal' is not a useful, concrete and tangible result.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **Claims 1 – 3, 7, 8, 11 – 13, 17 and 18**, claims 1 – 3, 7, 8, 11 – 13, 17 and 18 are directed to an apparatus which falls under one of the four enumerated statutory categories. However, the claims also fit a judicial exception. The claims can be interpreted as nothing more than program code. This is evidenced by figure 3 in Applicant's drawings which shows the apparatus as a computer system. Furthermore, claims 21 – 24, which claim a computer program similar to the apparatuses of claims 1 – 8, 11 – 13, 17 and 18 indicating that the apparatus is nothing more than program code.

Regarding **Claims 4 – 6, 9, 10, 14 – 16, 19 and 20**, claims 4 – 6, 9, 10, 14 – 16, 19 and 20 are directed to a method which falls under one of the enumerated statutory categories. However, the claims also fit a judicial exception. The claims can be interpreted as nothing more than program code. This is evidenced by figure 34, 5 and 16 in Applicant's drawings which shows the a method as a flow chart which indicates a software program. Furthermore, claims 21 – 24, which claim a computer program similar to the apparatuses of claims 1 – 8, 11 – 13, 17 and 18 indicating that the apparatus is nothing more than program code.

Regarding **Claims 21 – 24,** claims 21 – 24 appear to claim a program storage medium, however the claim is actually directed to a program. The claim includes language that limits the claim to make a learning apparatus execute the method set forth in the body of the claim. The actual body of the claim is directed to a program. A computer program is an abstract idea and is non-statutory.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,907,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the present application is broader. Claim

3 in the conflicting patent discloses that the extracting step includes having a DC component excepted. This DC component is the same as calculating an envelope.

Claim 2, 3, 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 4 of U.S. Patent No. 6,907,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the present application is broader as shown above. Additionally, regarding claim 2, the conflicting patent does not explicitly claim that the digital signal is an audio signal, however the entire specification is directed to that implementation.

Claims 7 – 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19 of U.S. Patent No. 6,907,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the present application is broader as shown above regarding claims 1 and 2.

Claim 21 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19, 23 and 25 of U.S. Patent No. 6,907,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim in the present application is broader.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7546. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

acf

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SUPERVISORY PATENT EXAMINER